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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/666,509

09/20/2000

Noah Prywes

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10/31/2006

rudoler & derosa llc

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SUITE 300

BALA CYNWYD, PA 19004

EXAMINER

SHINGLES, KRISTIE D

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,509

Applicant(s)

PRYWES, NOAH

Examiner

Kristie Shingles

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2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8,35-37 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 69-101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8,35-37 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 2-4, 6, 7, 9-34, 38-42 and 44-68 have been cancelled.

Claims 69-101 are newly added.

Claims 1, 5, 8, 35-37 and 43 are pending.

(Claims 69-101 are non-elected in election by original presentation)

Election/Restriction

1. Newly submitted claims 69-101 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed towards distributed data processing, wherein a request to perform a task is received and the task is performed in response to the request (709/201), which differs in inventive nature and scope from the originally filed claims which are directed toward demand based messaging (709/203).
2. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 69-101 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

3. The amendment filed 8/17/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

supported by the original disclosure is as follows: the claims are directed towards distributed data processing, wherein a request to perform a task is received and the task is performed in response to the request (Specification Amendment page 12).

Response to Arguments

4. Applicant's arguments filed 8/17/2006 have been fully considered but they are not persuasive.

Regarding Claim 1: Applicant argues that the cited prior art of record, *Nielsen* (US 6,108,688) and *Link II et al* (US 6,738,616) are “incompatible with each other” and combining the two inventions would “yield no benefit”.

Examiner respectfully disagrees. In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Nielsen* teaches that if an email message has not been received or responded to by a recipient, then the sender may use an alternative communication method, such as placing a telephone call, paging, etc. the recipient in order to communicate the desired message (col.2 lines 26-30, col.4 lines 13-19, col.8 lines 10-18 and 20-27). Likewise, *Link II et al*, teach a sender using other contact information of the recipient if communication using a specific contact method is unsuccessful (Abstract). Furthermore, *Link II et al*, teaches the ranking of contact information available to use, evident (in Figure 9) by the

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indexed forwarding telephone numbers. The combination of *Nielsen* with *Link II et al* thus provides a means for contacting a recipient by utilizing the various modes of contact information associated with that particular recipient, organized or index in order to particular hierarchy—such as from a frequently used contact number to a least frequently used contact number, fax number or email address. Applicant's arguments are therefore unpersuasive and the rejection under the prior art is maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 5, 8, 35-37 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* (US 6,108,688) in view of *Link II et al* (US 6,738,616).

a. **Per claim 1**, *Nielsen* teaches a method, system, computer-readable medium of automatically forwarding a response to a message to the sender of the message, comprising:

- (a) prompting the sender to provide a message; (b) prompting the sender to identify a recipient, the recipient having a plurality of associated contact numbers (col.1 lines 44-48, col.4 lines 13-19, col.8 lines 10-18 and 20-27; where if the system is able to contact the recipient by pager, email, phone, etc. it must also be able to associate each contact number with the proper receiving device to be able to execute the proper method of contact);
- (d) sending the message provided in response to step (a) to the associated contact number to which the message has not yet been sent; (e) prompting the recipient of the message to provide a reply to the message; (f) waiting at least a predetermined amount of time; (g) if no response to the message is received, repeating steps (d) through (g) with respect to the next associated contact number until a response is

received or the message has been sent to all associated contact numbers; and (h) forwarding the response to the sender (col.2 lines 4-30 and lines 57-67; where the email address of the recipient is ranked as first to contact and after no response a phone number, pager number, or faxed number is ranked next to contact the recipient).

Nielsen fails to explicitly teach prompting a user to rank the associated contact numbers. However, *Link II et al* teach (c) prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest; (d) sending the message provided in response to step (a) to the highest ranked associated contact number to which the message has not yet been sent; (e) prompting the recipient of the message to provide a reply to the message; (f) waiting at least a predetermined amount of time; (g) if no response to the message is received, repeating steps (d) through (g) with respect to the next highest ranked associated contact number until a response is received or the message has been sent to all associated contact numbers (Figure 9, col.3 lines 38-56, col.5 lines 14-28, col.7 lines 50-61, col.15 line 43-col.16 line 45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Nielsen* with *Link II et al* by prompting a user to rank the associated contact numbers because the sender may know which contact numbers the recipient is more likely to be able to be reached at thus decreasing response time because there will be fewer loops through the contact list before the recipient responds to the message thus making the system more efficient.

b. **Per claim 5**, *Nielsen* in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the channel of communication utilized by the recipient for sending the response is different from the channel of communication utilized by the sender for sending the message (col.2 lines 4-30).

c. **Per claim 8, *Nielsen*** in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the channel of communication utilized by the sender for sending the message is by automated telephone call (col.2 lines 28-30).

d. **Per claim 43, *Nielsen*** in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the message provided by the sender in response to step (a) comprises a plurality of questions; and wherein the recipient is prompted in step (e) to provide an answer to each question in the sender's message (col.3 lines 8-26).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Weiss et al (6,313,734), Wick et al (5,796,394), Brachman et al (6,501,838), Wierzbitzki et al (6,807,268), Myers et al (2004/0057562), Ditzik (6,167,376), Owens et al (6,633,630).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER